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OFFICE OF PETITIONS

Applicant: Sanders et al.

Appl. No.: 10/537,280

International Filing Date: November 28, 2003

Title: Binding Partners for the Thyrotropin Recepto and Uses Thereof

Attorney Docket No.: URQU.P-016

Pub. No.: US 2006/0241289 A1

Pub. Date: October 26, 2006

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on December 26, 2006, for the above-identified application

The request is granted-in-part.

Applicant requests that the application be republished because the patent application publication contains material errors, wherein the preliminary amendment to the specification was not included in the publication, as the Office did not follow its procedures and require a substitute specification and because an unrelated Figure 5 was included with the publication.

37 CFR 1.221 (b) is applicable "only when the Office makes a **material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.¹

The request for republication of the application with respect to the drawings is GRANTED. The corrected patent application publication will be published in due course, unless the patent issues before the application is republished.

The error noted by requestor with respect to the preliminary amendment is not an Office error. Applicant's assertion that the Office did not follow the procedure as set forth in the MPEP by

¹Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

requiring a substitute specification since the amendment filed with the application was not in a format usable for publication is not persuasive. A preliminary amendment filed upon the entry of the national stage of an international application under 35 U.S.C. 371 is not part of the original disclosure (because the filing date of the national stage application is the international filing date and not the national stage entry date) so the patent application publication need not include such an amendment.

The patent application publication does not include a mistake regarding the failure to include the preliminary amendment to the specification in the publication by the Office because patent application publications are not required to include preliminary amendments, according to 37 CFR 1.215(a),² which says the following, in part:

(a) ... The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. **The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under Sec. 1.125(b),** amendments to the abstract under Sec. 1.121(b), amendments to the claims that are reflected in a complete claim listing under Sec. 1.121(c), and amendments to the drawings under Sec. 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. (emphasis added)

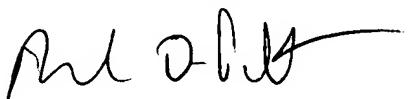
§ 1.215(c) says the following:

(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is sought under title 35, United States Code, whichever is later.

While the patent application publication may now include a preliminary amendment, the Office is not required to use the preliminary amendment. The Office changed the procedures for publication of patent applications so as to publish applications as amended, when possible. Until 2004, patent application publications were published as originally filed. See Patent Application Publications May Now Include Amendments, 1281 Off. Gaz. Pat. Office Notices 53 (April 13, 2004) and MPEP 1121. Applicant did not file a substitute specification, which incorporated the preliminary amendment. See Pre-Grant Publication Helpful Hint: File Continuation or Divisional Application with a New Specification and Copy of Oath or Declaration from Prior Application, 1251 Off. Gaz. Pat. Office Notices 54 (Oct. 9, 2001). The Office correctly published the application in accordance with 37 CFR 1.215(a).

²Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule, 69 FR 56482 (Sept. 21, 2004).

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